

REMARKS

The claims under examination are 36, 39 and 41-61; 63-78; 81-93; 95-100.

The claims stand rejected under 35 USC § 103(a) over Miles (*sic*) (US 5,662,891) (*sic*) or Bohm et al (US 4,948,586) or Fakhrudden (EP 697170).

- I -

Preliminarily, it is noted that the inventor of US 5,662,891 is Martin et al. not Miles et al.

Martin et al., describes a nail coating composition, which is substantially free to totally free of aromatic solvents, ketones and formaldehyde containing resins. This composition comprises *inter alia* nitrocellulose, maleic modified rosin based resin and polyester resin as the film forming, plasticizers; at least one vitamin; at least one UV blocking agent; at least one protein; at least one moisturizer; at least one smoothing agent; at least one adhesion promoter; and a mixture of organic solvents.

Thus, Martin et al. is neither directed to the formulation of agrochemicals nor does it involve process steps which might be comparable to the present invention.

Therefore, applicants assume that the examiner refers to Miller et al. (U.S. 5,662,897), a document cited in the previous office action.

It is further noted that the Miller et al. application (U.S. Ser. No. 281,916) is one of the two priorities for the EP application of Fakhruddin et al. (EP 697170, see the enclosed title page of EP 697170). Since the content of both specifications describe the same invention, applicants address Fakhruddin et al. and Miller et al. together

For convenience, these references will collectively be referred to as "Fakhruddin".

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The claims now use the language "consisting essentially of" which, as the examiner knows, excludes ingredients which would affect the basic and novel characteristics of the compositions of the claims. See, inter alia, *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963).

Further, and significantly, the claims now set forth that the normally UV deactivated pesticide retains its pesticidal activity in applicants' particular composition. This **limitation** breathes life and meaning to the claims, as note, inter alia, *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 866, 228 USPQ 90, 92 (Fed. Cir. 1985) ("Although it appears in the preambles of the '012 patent claims, the term 'anaerobic' breathes life and meaning into the claims and, hence, is a necessary limitation to them.")

Thus, these limitations *must* be taken into consideration when evaluating the prior art.

The rejection over Fakkruhdin (see supra) in view of Rheum et al.

As has previously been argued, in the process according to the present invention, a substantial number (about 90% or more) of the free carboxylic acid group in the pH-dependent polymer have not been converted to their salt form. This is achieved by the process of the present invention, which requires partial solubilization of the pH-dependent polymer (see e.g. claim 36 (3) "...wherein the mixtures pH is less than the polymer's solubilization pH;...").

Contrarily, the process according to Fakkruhdin requires total solubilization of the pH-dependent polymer (see e.g. page 18, claim 1, lines 36-37 of Fakkruhdin et al.

"dissolving the pH-dependent polymer by adjusting the pH of the mixture... above the solubilization pH..."). Thus, the free carboxylic acid groups of the pH-dependent polymer will be present in the matrices and compositions containing those matrices prepared according to Fakkruhadin et al. in their salt form.

Applicants point at example 6 of the present invention, which is a comparative example between EP 697170 (Fakkrudin et al. and therefore also Miller et al.) with the present invention. This example clearly discloses the superior properties of formulations prepared according to the present invention if compared with formulations according to Fakkruhadin et al. As is apparent to the skilled artisan, the stability of formulation depends on the polymer employed. If the formulation according to Fakkruhadin (control composition of table IX, comprises copolymer Eudragit® S100) is compared with a formulation comprising the same copolymer (composition 34 of table IX, comprises copolymer Eudragit® S100), the composition prepared according to the present invention has significantly greater residual activity (see example 6). Compositions 36, 37 and 45 of table IX comprise different copolymers (36 comprises 36 Kollicoat® MAE 30D; 37 comprises Eudragit® L30D and 43 comprises Eudragit® L100) and can therefore not be correctly compared with the control composition of Fakkhrudin.

According to Rheume et al. the polymer used for coating is precipitated out of solution by "modifying the charge of a sufficient quantity of the functional groups of the charged polymer by adding a precipitant" (see e.g. col. 14, claim 1, lines 53-60, col. 3, lines 10 to 15). It is clear, that a partially solubilized polymer cannot properly be viewed as equivalent to nor suggested by a precipitated-out polymer. Contrarily, a partially-

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solubilized polymer is not precipitated out of solution because it both

- (a) remains in suspension within the aqueous mixture; and
- (b) is partially-solubilized.

In the present invention, the coated matrixes are obtained by a drying and not by a precipitation process. Thus, there is no hint in the teaching of Rheume et al. for a process of production of coated pesticidal matrixes involving partial solubilization of a pH dependent polymer, if one avoids hind-sight view.

Accordingly, the references lack the necessary reason, suggestion or motivation to modify Fakkruhadin to come up with applicants' invention, particularly when taking into account the foregoing amendments, *at the time the invention was made*. Hindsight is a tempting but forbidden zone.

The rejection over Bohm et al in view of Rheume et al.

A most significant difference between Bohm et al. and the present application we would like to point out that applicants' process is a 100% aqueous one; Bohm et al. is a mixture of aqueous and organic solvents in every case (for example see page 5, line 61 ff of U.S. 4,948,586). As indicated in claim 1 of Bohm et al. and claim 1 of the present application, the processes employed to produce the formulations are completely different.

It is clear that the language "consisting essentially of," as discussed above, necessarily excludes the organic solvents of Bohm et al. Lacking from Bohm et al. is (a) the use of a partially solubilized polymer and/or (b) the use of a 100% aqueous process. The examiner's attention is once again asked to note the "consisting essentially of"

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limitation which clearly excludes Bohm et al.'s organic solvent.

As explained above, there is no hint in the teaching of Rheume for a process of production of coated pesticidal matrixes involving *partial* solubilization of a pH dependent polymer. Accordingly, its combination with Baum provides no reason, suggestion or motivation to modify Bohm et al in such a manner as to come up with applicants' invention.

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For the reasons set out above, allowance is respectfully solicited. However, should the examiner disagree, it is requested that the amendment be entered for the purpose of appeal.

A check for \$110.00 is attached for a one month extension of time. Should this be deficient, kindly charge Deposit Account No. 11-0345.

Respectfully submitted,

KEIL & WEINKAUF



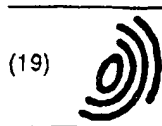
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solution)

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(54) Coated pesticidal agents, processes for their preparation and compositions containing them

(57) The present invention provides a coated pesti-
cidal agent and processes for its preparation. The
present invention also provides a wettable powder pes-ticial composition containing the coated pesticidal
agent.

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